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Harrison

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF : :

CHARLES LEROUX : GROUP ART UNIT: 2813

SERIAL NO: 09/889,558 : EXAMINER: THOMPSON, C.

FILED: AUGUST 3, 2001 : :

FOR: DEVICE PROVIDING PROTECTION  
AGAINST ELECTROSTATIC DISCHARGE ...

PROVISIONAL ELECTION

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

In response to the Restriction Requirement dated *February 12, 2002*, Applicant elects with traverse Claims 11-17 in Group I, drawn to a device. Applicant makes this election based on the understanding that Applicant is not prejudiced against filing one or more divisional applications that cover the non-elected claims.

In addition to making this election, Applicant respectfully traverses this Restriction Requirement for the reason that the inventions of Groups I and II have not been shown to be in violation of the unity of invention requirement stated in PCT Rule 13.2. Under 13.2, the requirement of the unity of invention is fulfilled when there is a technical relationship among the inventions involving one or more of the same or corresponding special technical features. Thus, for there to be no unity of invention, the claims of Group I and the claims of Group II have to be analyzed to see if there exists no same or corresponding special technical features.

However, page 2 of the Restriction Requirement states, in support of its position that

the claims lack one or more of the same or corresponding special technical features, that “the device(s) of Claims 11-17 can be made through a plurality of distinct processes from those of claims 18, and 19, including in situ doping rather than ion implantation.” No analysis of the claims for one or more of same or corresponding special technical features appears to be made. Furthermore, since the specific steps of the process proposed in the Office Action are not given, Applicant can not determine even if the process proposed is a distinct process from the claimed invention, as asserted in Restriction Requirement.

Because the Restriction Requirement fails to provide a basis for determining that the claims do not have a technical relationship among the inventions involving one or more of same or corresponding special technical features, it is respectfully submitted that the outstanding restriction cannot be said to have fulfilled the requirement of PCT Rule 13.2. Accordingly, the restriction is traversed.

Furthermore, MPEP § 803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area. Accordingly, Applicant respectfully traverses the Restriction Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner, whereas it would clearly be burdensome on the Applicant to be required to file, prosecute and maintain separate applications and patents on the identified.

Accordingly, it is respectfully requested that the requirement to elect a single group be withdrawn, and that a full examination on the merits of Claims 11-19 be conducted.

Respectfully submitted,

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